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REMARKS

Claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51 stand rejected under 35 U.S.C 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). Claims 3, 7, 9, 14, 18, 20, 25, 29, 43, 48 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Bartholomew in view of McAllister, Silverman, or Baker. As will be shown below, Bartholomew, McAllister, Silverman, and Baker, alone or in combination, do not teach a method, system, or computer program product for identifying a particular callee reciting the limitations of "identifying, *at said origin device*, a callee identity associated with said utterance," "means for identifying, *at said origin device*, a callee identity associated with said utterance," and "means, recorded on said recording medium, for detecting a voice utterance . . . at *an origin device*." Claims 1-30 and 40-51 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-30 and 40-51.

Election/Restriction

The Office Action of April 8, 2003 identifies two groups within the 51 claims filed in the present application. Group I includes claims 1-30 and 40-51. Group II includes claims 31-39. In a telephonic interview on March 21, 2003, Applicants provisionally elected with traverse Group I including claims 1-30 and 40-51 for prosecution in the present case. Applicants affirm the provisional election with traverse of Group I including claims 1-30 and 40-51. Please cancel claims 31-39.

Claim Rejections – 35 U.S.C. §102

Claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51 stand rejected under 35 U.S.C 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). "A claim is anticipated only if each and every element as set forth in the

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claim is found, either expressly or inherently described, in a single prior art reference."¹ Because Bartholomew does not teach each and every element of claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51, the rejection should be withdrawn and the claims should be allowed.

The present application is entitled "Origin Device Based Callee Identification" and each independent claim in the case recites "an origin device." Independent claim 1 recites "[a] method for identifying a particular callee, said method comprising . . . detecting, *at an origin device*, a voice utterance . . . and identifying, *at said origin device*, a callee identity associated with said utterance. . . ." Independent claim 12 similarly recites "[a] system for identifying a particular callee, said system comprising . . . means for detecting, *at an origin device*, a voice utterance . . . and means for identifying, *at said origin device*, a callee identity associated with said utterance. . . ." Independent claim 23 recites "[a] computer program product for identifying a particular callee, said computer program product comprising . . ." means, recorded on said recording medium, for detecting a voice utterance . . . *at an origin device*." Independent claim 40 recites "[a] method for identifying a callee, comprising: . . . authenticating an identity of said callee from said voice utterance *at said origin device*." Independent claim 45 recites "[a] system for identifying a callee, comprising: . . . means for authenticating an identifying of said callee from said voice utterance *at said origin device*." Independent claim 51 recites "a computer program product for identifying a callee comprising: . . . means, recorded on said recording medium, for authenticating an identifying of said callee from said voice utterance *at said origin device*." Rejected claims 2, 4, 8, 10, 11, 13, 15, 19, 21, 22, 24, 26, 41, 42, 44, 46, 47, 49, and 50 depend from independent claims 1, 12, 23, 40, and 45 and include all of the limitations of those independent claims.

In rejecting claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 40- 42, 44-47, and 49- 51 the office action states that the 'IP 23' of Bartholomew "reads on the claim 'origin device'."² The IP of Bartholomew is not an origin device as recited in claims 1, 2, 4, 8, 10- 13, 15,

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² Office Action Dated April 8, 2003, paragraph 7.

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19, 21- 24, 26, 40- 42, 44-47, and 49- 51. The IP of Bartholomew is an acronym for "intelligent peripheral." Bartholomew specifically incorporates the definition of the IP from another patent to Wheeler, Jr.³ who describes the IP as "a *separate network component* that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network."⁴ In fact, Bartholomew demonstrates that the IP is not an origin device stating that "when there is an *outgoing call* . . . the network will *route the call to the IP 23* . . ."⁵ Because the IP of Bartholomew is not an "origin device," the rejection of claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 40- 42, 44-47, and 49- 51 be withdrawn.

Independent claims 1, 12, and 23, also recite "said callee identity is transmittable as an authenticated identity of said callee for a call." The office action does not mention the phrase or demonstrate how Bartholomew teaches a "callee identity is transmittable as an authenticated identity of said callee for a call." Independent claims 1, 12, and 23, as well as their rejected dependent claims 2, 4, 8, 10, 11, 13, 15, 19, 21, 22, 24, and 26 should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 7, 9, 14, 19, 20, 25, 29, 43, and 48 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of U.S. Patent No. 6,101,242 to McAllister, U.S. Patent No. 5, 875, 240 to Silverman, or U.S. Patent No. 5, 533, 109 to Baker. Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met.⁶ First, the combination must teach or suggest all of

³ U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. U.S. [sic] Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.")

⁴ U.S. Patent No. 5, 572, 583, abstract, emphasis added.

⁵ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

⁶ Manual of Patent Examining Procedure §2142.

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Applicants' claim limitations.⁷ Second, there must be a suggestion or motivation to combine the references.⁸ Finally, there must be a reasonable expectation of success in the combination.⁹

Bartholomew and McAllister

Claims 3, 14, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of McAllister. The combination of Bartholomew and McAllister cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and McAllister does not teach or suggest all of Applicants' claim limitations. Rejected claims 3, 14 and 25 depend from claims 1, 12, and 23 respectively and include the limitations "identifying, *at said origin device*, a callee identity associated with said utterance," "means for identifying, *at said origin device*, a callee identity associated with said utterance," and "means, recorded on said recording medium, for detecting a voice utterance . . . *at an origin device*." Neither Bartholomew nor McAllister teach these limitations. In fact, both Bartholomew and McAllister incorporate the same definition of an IP from another patent to Wheeler, Jr.¹⁰ Because the combination of Bartholomew and McAllister does not teach each and every limitation of claims 3, 14, and 25, the combination of Bartholomew and McAllister cannot establish a *prima facie* case of obviousness.

⁷ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

⁸ *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁹ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

¹⁰ U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference."); U.S. Patent No. 6,101,242, column 12, lines 48-57 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.").

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There is also no suggestion or motivation to combine Bartholomew and McAllister. There is no suggestion or motivation to combine Bartholomew and McAllister because both references lack the same teaching. That is, both references do not teach, for example, "identifying, *at said origin device*, a callee identity associated with said utterance." There is no suggestion or motivation to combine the references, because the resultant combination still does not teach the limitations of claims 3, 14, and 25.

There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and McAllister fail to teach "identifying, *at said origin device*, a callee identity associated with said utterance" the combination cannot work to identify, "*at said origin device*, a callee identity associated with said utterance." That is, Bartholomew and McAllister together cannot teach what is not disclosed in either reference alone. The combination therefore fails to establish a *prima facie* case of obviousness.

Bartholomew and Silverman

Claims 7, 18, 29, 43, and 48 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Silverman. The combination of Bartholomew and Silverman also cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of claims 7, 18, 29, 43, and 48, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The combination of Bartholomew and Silverman does not teach each and every element of claims 7, 18, 29, 43, and 48. Claims 7 recites "displaying said callee identity to said caller *at said origin device*," claim 18 recites "means for displaying said callee identity to said caller *at said origin device*." Claim 29 recites "means, recorded on said recording medium, for controlling output of said callee identity to said caller *at said origin device*," Claims 43 and 48 depend from claims 40 and 45 and therefore include the limitation "enabling output of said authenticated identity *from said origin device* . . . wherein said output comprises displayable output to a graphical user interface" and "means for

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enabling output of said authenticated identity *from said origin device . . . wherein said output comprises displayable output to a graphical user interface.*"

The office action states "Silverman teaches displaying the called party identification information at the end-user device to which the call is routed before the call is answered."¹¹ The "end-user device to which the call is routed before the call is answered"¹² cannot be an origin device, because it is the device *to which the call is routed*. The proposed combination of Bartholomew and Silverman therefore fails to teach each and every limitation of claims 7, 18, 29, 43, and 48, and cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Silverman, because both Bartholomew and Silverman lack the same teaching. Both Bartholomew and Silverman do not teach 'displaying said called identity *to said caller at said origin device*' as recited in claims 7, and 18, "means, recorded on said recording medium, for *controlling output of said callee identity to said caller at said origin device,*" as recited in claim 29, or "enabling output of said authenticated identifying from said origin device . . . wherein said output comprises displayable output to a graphical user interface" as recited in claims 43 and 48. There is no suggestion or motivation therefore to combine Bartholomew and Silverman, because the resultant combination still does not teach the limitations of claims 7, 18, 29, 43, and 48.

There is no reasonable expectation of success in the combination of Bartholomew and Silverman. The proposed combination teaches that "the routed call includes the called party identification information, which may be displayed on the end-user device *to which the call is routed* before the call is answered." The combination will not work to display "said called identity," control "output of said callee identity" or enable "output of said authenticated identity" at or from "said origin device" as recited in claims 7, 18, 29, 43, and 48, because it teaches displaying "on the end-user device *to which the call is routed.*"

¹¹ Office Action Dated April 8, 2003, paragraph 7.

¹² U.S. Patent No. 5, 875,240; column 2, lines 51-55.

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Bartholomew and Baker

Turning now to claims 9 and 20, claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Bartholomew in view of Baker. The combination of Bartholomew and Baker also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The proposed combination of Bartholomew and Baker does not teach each and every element of claims 9, and 20. Claim 9 depends from independent claim 1 and also includes the limitation "identifying, *at said origin device*, a callee identity." Claim 20 depends from claim 12 and includes the limitation "means for identifying, *at said origin device*, a callee identity." Neither Bartholomew nor Baker teach identifying, *at said origin device*, a callee identity. Because the proposed combination of Bartholomew and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Baker because both references lack the same teaching. Neither Bartholomew nor Baker teach "identifying, *at said origin device*, a callee identity." There is no suggestion or motivation to combine Bartholomew and Baker because the resultant combination still fails to teach each element of claims 9 and 20. Bartholomew and Baker therefore cannot establish a prima facie case of obviousness.

There is also no reasonable expectation of success in the combination. Because neither Bartholomew nor Baker teach "identifying, *at said origin device*, a callee identity" the combination cannot work to identify, "*at said origin device*, a callee identity." That is, Bartholomew and Baker together cannot teach what is not disclosed in either reference

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alone. The combination of Bartholomew and Baker cannot establish a prima facie case of obviousness.

Conclusion

Bartholomew alone or in combination with McAllister, Silverman, or Bake does not teach each and every element of claims 1-30 and 40- 51. Bartholomew therefore does not anticipate claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47 and 49-51.

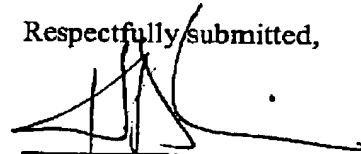
The proposed combinations of Bartholomew and McAllister, Silverman, and Blake fail to establish a prima face case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants respectfully request the allowance of claims 1-30 and 40-51.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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By:

Respectfully submitted,



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